

Appln. No. 10/520,008
Amd. dated February 18, 2009
Reply to Office Action of November 25, 2008

REMARKS

The Office Action and the cited and applied references have been carefully reviewed. No claim is allowed. Claims 3-10 and 17-27 presently appear in this application and define patentable subject matter warranting their allowance. Reconsideration and allowance are hereby respectfully solicited.

Claims 3-10 and 17-27 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. While applicants do not agree with the examiner's position, this rejection is obviated by the amendments to claims 17 and 18 to change the recitation of "which consists of" to "having", as recited in the original claims. In addition, the DNA is defined by the steps for its preparation as supported in the specification at page 10, lines 7-18.

Reconsideration and withdrawal of the rejection are therefore respectfully requested.

Claims 17 and 23-27 have been rejected under 35 U.S.C. §102(b) as being anticipated by Ohshima et al., US 5,643,762. This rejection is respectfully traversed.

Ohshima discloses the introduction of a plasmid containing an invented repeat sequence into cells to produce a

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DNA having a stem-loop configuration. Thus, the disclosures of Ohshima are limited to only the production of a DNA-having a stem-loop configuration by introduction of such a mutation. Ohshima however provides no disclosure or teaching of the introduction of a mutation into a nucleic acid by utilizing the DNA obtained by Ohshima's method.

Ohshima does not disclose or teach the production of the DNA by "excising an inverted repeat DNA insert from a plasmid containing an inverted repeat DNA insert in which two identical genes or fragments thereof are arranged in opposite directions, or by amplifying said inverted repeat DNA using said plasmid as template", as recited in the present amended claims, and the method for introducing the resultant DNA into cells as claimed in amended claims 17 and 18.

Accordingly, Ohshima cannot anticipate the presently claimed invention.

Reconsideration and withdrawal of the rejection are therefore respectfully requested.

Claims 3-10 and 17-27 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Ohshima et al. in view of Wengel et al., WO99/14226, Dean et al., US 6,130,207 and Bissler et al., *Frontiers in Biosciences*, 3:d408-418 (1998). This rejection is respectfully traversed.

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The deficiencies of Ohshima are discussed above in the §102(b) anticipation rejection. With regard to the secondary references, Wengel discloses a modified nucleotide, a nucleic acid containing LNA, Dean discloses a plasmid containing a plasmid containing a sequence specifically binding to a transcription factor, and Bissler discloses the presence of an inverted repeat sequence on eukaryotic cell genomes. These cited and applied secondary references however do not teach or suggest the production of the DNA by "excising an inverted repeat DNA insert from a plasmid containing an inverted repeat DNA insert in which two identical genes or fragments thereof are arranged in opposite directions, or by amplifying said inverted repeat DNA using said plasmid as a template", as recited in the present claims. Accordingly, the cited and applied secondary references do not satisfy the deficiencies of the primary Ohshima reference and thus, even if combined with Ohshima, cannot lead one of ordinary skill in the art to the presently claimed invention.

Reconsideration and withdrawal of the rejection are therefore respectfully requested.

In view of the above, the claims comply with 35 U.S.C. §112 and define patentable subject matter warranting

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their allowance. Favorable consideration and early allowance
are earnestly urged.

Respectfully submitted,

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